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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,188	09/24/2003	Jay A. Jupiter	14987.0002	4123
27890 7590 08/19/2008 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			EXAMINER SHIBRU, HELEN	
			ART UNIT 2621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,188

Applicant(s)

JUPITER, JAY A.

Examiner

HELEN SHIBRU

Art Unit

2621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-8, 10, 15, 16 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-8, 10, 15-16, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendments, filed 12/13/2007, have been entered and made of record. Claims 1, 6-8, 10, 15-16 and 22 are pending.

Response to Arguments

2. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. Claims 1, 6-8, 10, 15-16 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites "one or more control keys mounted on the base and operably connected to the disc reader and accessible during display of the still while the lid is in the closed position...." The Examiner noted that the specification discloses the keys can be mounted on the base and on the lid. However while the lid is in the closed position, keys that are accessible are the one mounted on the lid not on the base as the claim recited. See the specification (paragraph 0007) where it discloses 'wherein the lid when in the closed position encloses the CD-ROM and exposes the integrates display screen.' See also figure 1 where it shows key 3 and display on the outer surface of the lid. Therefore the claims are rejected broadly and as they recited.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6-8, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii (US Pat. No. 5,265,083) in view of Mizoguchi (US Pat. No. 6,374,040) and further in view of Boothroyd et al. (US Pat. No. 5,267,123).

Regarding claim 1, Ishii discloses a portable digital image viewer comprising: a base including a disc reader configured to read a digital image file from a disc (see fig. 2, col. 3 lines 41-47 and col. 5 lines 48-55 where it discloses a head driving section and a printed circuit board to process a reproduction signal are enclosed in the casing of the main portion body 2 in fig. 2); and an integrated display screen configured to display a still image from the digital image file (see abstract, col. 7 lines 14-30 and col. 9 lines 8-20);

a controller, wherein the digital image file is a JPEG, GIF, TIFF or bitmap file and the controller is configured to decode the digital image file for display on the integrated display screen (see col. 1 lines 12-20, col. 7 lines 14-30 and fig. 11);

a lid attached to the base by a hinge and swinging between an open position and a closed position, and encloses a compact disc (see abstract, col. 3 lines 54-61 and col. 5 lines 6-28, when the cover closes it will close the disc as well. Note that the claim does not specifically recites **during** reproduction or operation of the viewer, and therefore Ishii still meet the limitation);

one or more control keys mounted on the base or on the lid and operably connected to the disc reader (see col. 3 lines 49-53, col. 10 lines 1-9, and figs 3 and 6), the control key is

configured to advance a first still image displayed on the screen to a second still image (see col. 10 lines 1-9).

Claim 1 differs from Ishii in that the claim further requires a lid including the integrated display screen on an outer surface of the lid.

In the same field of endeavor Mizoguchi discloses a cover unit that rotates and detachable and the cover provided with display unit (see col. 5 lines 45-48). See also claim 3 which recites a display in the back side of the frame. Mizoguchi further discloses the lid is attached to the base by a hinge and swinging between an open position and a closed position, and encloses a compact disc (see claim 3, when the cover closes it will close the disc as well). Therefore in light of the teaching in Mizoguchi it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishii by providing a display on an outer surface of the lid in order to view the image in the back.

Claim 1 further differs from the above proposed combination in that the claim further requires accessing the one or more control keys that are mounted on the base during display of the still image while the lid is in the closed position.

In the same field of endeavor Boothroyd discloses having display accessible when lid is closes over the key board (see title). Boothroyd further discloses the lid 12 incorporates a display which is visible at the upper surface of the lid in the closed condition of the case (see fig. 1 and col. 3 lines 44-54). Boothroyd further teaches the keyboard occupies the front part of the base 10. Boothroyd further teaches the lid can be detached from the base, and the communication between the base and the lid is performed by a multi-way plug socket adapted, i.e. the key board mounted on the base is accessible while the lid is in the detachable condition also. Therefore in

light of the teaching in Boothroyd it would have been to one of ordinary skill in the art at the time the invention was made to modify the above proposed combinations by accessing keys mounted on the base while displaying the still image in order to visualize the display even when the case is closed (see col. 2).

Regarding claim 6, Ishii discloses the integrated display screen is a color screen (see col. 7 lines 14-30).

Regarding claim 7, Ishii discloses the color screen has a diagonal dimension of no more than 6 inches (see col. 5 lines 36-41, where it shows the screen is 4 inches).

Regarding claim 8, Ishii discloses the disc reader includes a laser that operates at a wavelength longer than 750 nm (see col. 8 lines 10-28 where it teaches a semiconductor laser is used, and it is inherent that semiconductor laser emits wavelength above 750nm).

Regarding claim 10, the limitation of claim 10 can be found in claims 1 and 8. Therefore claim 10 is analyzed and rejected for the same reason as discussed in claims 1 and 8 above.

Regarding claim 15, Ishii discloses the viewer is configured to display a digital image at full size on the integrated display screen (see col. 7 lines 14-30).

6. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii in view of Mizoguchi (US Pat. No. 6,374,040) and further in view of Boothyard (US Pat. No. 5,267,123) and Official Notice.

Regarding claim 16, Ishii discloses a portable digital image viewer comprising: a base including a disc reader configured to read a digital image file from a compact disc (see rejection of claim 1 above); and an integrated display screen configured to display a still image from the digital image file (see rejection of claim 1 above);

a lid including the integrated display screen, the lid being attached to the base by a hinge and swinging between an open position and a closed position, wherein the lid when in the closed position encloses the disc (see abstract, col. 3 lines 54-61 and col.5 lines 6-28, when the cover closes it will close the disc as well. Note that the claim does not specifically recites **during** reproduction or operation of the viewer, and therefore Ishii still meet the limitation); and

one or more control keys mounted on the base or on the lid and operably connected to the disc reader (see col. 3 lines 49-53, col. 10 lines 1-9, and figs 3 and 6), the viewer is configured to display a still image generated from a digital image at full size on the integrated display screen (see col. 7 lines 14-30).

Claim 16 further differs from the above proposed combination in that the claim further requires accessing the one or more control keys that are mounted on the base during display of the still image while the lid is in the closed position.

In the same field of endeavor Boothroyd discloses having display accessible when lid is closes over the key board (see title). Boothroyd further discloses the lid 12 incorporates a display which is visible at the upper surface of the lid in the closed condition of the case (see fig. 1 and col. 3 lines 44-54). Boothroyd further teaches the keyboard occupies the front part of the base 10. Boothroyd further teaches the lid can be detached from the base, and the communication between the base and the lid is performed by a multi-way plug socket adapted, i.e. the key board mounted on the base is accessible while the lid is in the detachable condition also. Therefore in light of the teaching in Boothroyd it would have been to one of ordinary skill in the art at the time the invention was made to modify the above proposed combinations by accessing keys

mounted on the base while displaying the still image in order to visualize the display even when the case is closed (see col. 2).

Claim 16 differs from the proposed combination in that the claim further requires an input port for a digital memory card configured to read a digital image file from a digital memory card. Although Ishii does not specifically disclose in the detailed description, Ishii discloses using a joy card in the conventional CD_I system.

Official Notice is taken that using a digital memory card in a portable image viewer is well known in the art in order to save data. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an input port for a digital memory card in order to connect a removable memory.

Claim 16 further differs from the proposed combination in that the claim further requires to display the one or more images as a thumbnail.

Official Notice is taken that displaying still image as a thumbnail is well known in the art in order to represent the image in smaller size. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to display a thumbnail image for the users to search data.

Regarding claim 22, Ishii discloses the disc reader includes a laser that operates at a wavelength longer than 750 nm (see col. 8 lines 10-28 where it teaches a semiconductor laser is used, and it is inherent that semiconductor laser emits wavelength above 750nm).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/
Examiner, Art Unit 2621
August 4, 2008

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621